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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 16
EWH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mother's Cake & Cookie Co.

Serial No. 75/380,510

Robert T. Johnson, Jr., of Bell, Boyd & Lloyd for Mother's
Cake & Cookie Co.

Barbara Sundberg Loughran, Trademark Examining Attorney, Law
Office 101 (Jerry Price, Managing Attorney).

Before Seeherman, Hanak and Drost, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Mother's Cake & Cookie Co. (applicant) seeks to
register COCONUTTY! in typed drawing form for "cookies."
The intent-to-use application was filed on October 28, 1997.

Citing Section 2(e)(1) of the Trademark Act, the
Examining Attorney has refused registration on the basis
that applicant's mark is merely descriptive of an important
characteristic and/or ingredient of applicant's cookies.

When the refusal to register was made final, applicant
appealed to this Board. Applicant and the Examining
Attorney filed briefs. Applicant did not request a hearing.

During the course of this proceeding, applicant filed

an amendment to allege use, which was accepted by the Examining Attorney. The specimen of use makes it clear that the cookies on which applicant uses its mark COCONUTTY! are coconut bars or coconut cookies. Moreover, the specimen of use makes it clear that these particular cookies contain coconut.

The Examining Attorney has made of record a substantial body of evidence demonstrating that long prior to applicant's filing date of October 28, 1997, others had used the word "coconutty" to describe not only cookies and other baked goods, but also other food and beverage products. For example, in the January 11, 1992 edition of the Madison Capital Times (Wisconsin) there appears the following sentences: "All of Madison awaits the beginning of the 1992 Girl Scout cookie sale ... This year there's a new cookie, Praline Royal, and we've gotten an advance box. It's coconutty with a sort of pecan flavor, and we recommend it." Likewise, the April 1994 issue of Redbook refers to a "coconutty mocha cookie cake." Indeed, as early as February 6, 1981 The Washington Post described a German chocolate cake with a "thick and coconutty icing." Moreover, the July 11, 1985 edition of The San Diego Union-Tribune discusses a

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"coconutty pie." The foregoing are just some of the many stories appearing long before applicant's filing date wherein the word "coconutty" is used to describe the flavor of certain cookies and other baked goods.

Subsequent to applicant's filing date, there were additional stories wherein the word "coconutty" appeared in connection with cookies and other baked goods. For example, the November 13, 1997 edition of The Chattanooga Times talks about a "coconutty oatmeal pie." Moreover, the word "coconutty" has been used to describe the flavor of other food and beverage items, including such diverse items as mixed drinks and batter for shrimp.

In arguing that its purported mark COCONUTTY! is not merely descriptive, applicant makes essentially three arguments which it styles as A (brief pages 2-5); B (brief pages 5-6); and C (brief page 7).

Applicant's first argument is that it made of record ten third-party registrations for various food items wherein the word "nutty" was not disclaimed. Applicant then argues that "the fact that a disclaimer of the term 'nutty' was not required underscores the fact that 'nutty' is not descriptive as used by applicant." (Applicant's brief page

3). Obviously, this Board and certainly our primary reviewing Court are not bound by the actions of Examining Attorneys. West Florida Seafood v. Jet Restaurants, 31 F.3d 1122, 31 USPQ2d 1660, 1664 (Fed. Cir. 1994). Suffice it to say that, based upon the massive body of evidence submitted by the Examining Attorney where the word "coconutty" is used to describe cookies, other baked goods and a wide array of other food and beverage products, we have no doubt that as applied to applicant's cookies, which are coconut cookies or coconut bars containing coconut, the mark COCONUTTY! is clearly merely descriptive.

Second, applicant argues that its mark COCONUTTY! has a double entendre or double meaning and hence is entitled to registration. In this regard, applicant cites the case of In re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) wherein the Court held that the mark SUGAR & SPICE was not merely descriptive for bakery products because it brought to mind the well known children's rhyme. Applicant claims that its mark COCONUTTY! has a double entendre like SUGAR & SPICE because its mark COCONUTTY! "can mean 'nutty' as in crazy." (Applicant's brief page 6). In support of this argument, applicant points to the following

sentence appearing in small type on its packaging beneath its mark COCONUTTY!: "We went a little crazy and put enough of our delicious Cocadas coconut cookies to fill an 18 ounce bag."

We find applicant's argument to be flawed for three reasons. First, given the massive amount of evidence which the Examining Attorney has made of record demonstrating that the word "coconutty" is widely used to describe cookies and other baked goods, we have no doubt that consumers, upon seeing applicant's mark on cookies, would immediately understand that the cookies have a coconut flavor (perhaps an extra coconut flavor) and/or contain coconut.

Second, given the somewhat small typeface in which the phrase "We went a little crazy..." appears, it is unlikely that consumers would even notice this phrase. Moreover, even if they did, we do not believe that consumers would attribute a double meaning to applicant's mark COCONUTTY!

Finally, should applicant obtain a registration for COCONUTTY! for cookies, it could at any time in the future delete the phrase "We went a little crazy..." from its packaging and make no reference to the word "crazy" or any similar word.

Applicant's final argument is that in deciding whether a mark is merely descriptive or is suggestive, doubts should be resolved in applicant's favor. We accept applicant's argument, but as previously stated, we have no doubt that consumers, upon seeing COCONUTTY! on cookies, would immediately understand that these cookies are coconut flavored and/or contain coconut.

Two final points deserve comment. While applicant did not raise this argument, it has not escaped our attention that applicant's mark ends with an exclamation point. However, a slight alteration of a descriptive word will not turn that descriptive word ("coconutty") into a non-descriptive mark. 1 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:31 at page 11-52 (4th ed. 2000).

Second, if applicant had sought to register COCONUT for cookies, that term would be held to be at least merely descriptive, if not generic for, a type of cookie. Even if the Examining Attorney had not presented the foregoing substantial body of evidence showing that others have used the word "coconutty" to describe cookies and other baked goods, we would still be inclined to view the word

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"coconutty" as but an adjective form of the word "coconut," and hence still merely descriptive. In this regard, Professor McCarthy notes that the addition of such suffixes as "er" or "-ize" to descriptive words in most cases result in words which are still descriptive. 2 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 11:29 at pages 11-50 to 11-51 (4th ed. 2000).

Decision: The refusal to register is affirmed.

